

REMARKS

Reconsideration of the subject application in view of the above amendment is respectfully requested.

By the present amendment, claims 1, 5-7, 11, 13, 15-19 and 21-22 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 1-24 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 5-7, 11, 13, 15-19 and 21-22 have been amended to overcome this rejection. Claims 2-4, 8-10, 14, 20, and 23-24 depend on the amended claims and are allowable for the same reasons such claims are allowable. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

The Examiner has rejected claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,903,462 (Wagner) and claims 1, 4 and 24 under 35

U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,051,351 (Mallick).

Applicants respectfully disagree with this rejection.

Claim 1 recited that the acceleration forces $\underline{a}(t)$ are detected by at least one sensing device. The average acceleration is thereby described by $\underline{a} = \Delta v / \Delta t$ (where t is time and v is the speed at t) and is measured in m/s^2 (meters/seconds²). When the acceleration force is measured, the mass of the acceleration object must be included.

In contradistinction, in Wagner torque is measured by a sensor (306). The definition of torque is the measure of the force applied to produce rotational motion usually measure in Nm (Newton meter). Torque is determined by multiplying the applied force (F) by the distance (r) from the pivot point to the point where the force is applied. Furthermore, time is not included in the measures of torque. Hence, the torque as measured by the sensor (306) of Wagner is neither equal nor comparable to the acceleration forces $\underline{a}(t)$ measured by the sensing device of the present invention.

The electronic system for monitoring pneumatic tool performance as disclosed in Mallick does not measure acceleration forces $\underline{a}(t)$ of the tool itself. The disclosed system only calculates the total energy that is delivered to the piston. It is not possible to determine the acceleration forces occurring in the tool, as these accelerations are

indirect products of the work that is performed by the tool and the piston reciprocating therein (like accelerations caused by backstrokes in power driven tools).

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Wagener and Mallick each fail to disclose each and every feature of independent claim 1, each such reference, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Wagner and Mallick do not anticipate or make obvious the present invention as defined in claim 1, and the present invention is patentable over such references. Claims 2-8, and 24 depend on claim 1 and are allowable for the same

reasons claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1 are not disclosed or suggested in the prior art.

The Examiner has rejected claims 9-23 under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of U.S. 2003/0006051 (Schmitzer). Applicants respectfully disagree with these rejections.

The electrical hand held power tool as disclosed in Schmitzer uses acceleration signals detected by a sensor to actively damp vibrations. An actuator (5a, 5b) is dynamically controlled by a microprocessor (7), which processes the signals derived from the sensor on the handle (2) (col. 1, 3rd par.). The signals derived from the sensor are processed instantly so that a damping of actual vibrations can be realized. Furthermore, the algorithm included in the microprocessor is not set to detect a physiological acceleration load A absorbed by an operator, as these would mean that the data are additively processed in the microprocessor. An additive processing would lead to a damping activity of the actuators that is stronger in a certain moment as the actually measured vibration. A combination of Wagner and Schmitzer would thus not lead one of skill in the art to the invention of claims 9 and claim 10-23 that depend there from.

A *prima facie* case of obviousness has not been met by the Examiner.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983): SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levensgood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would

have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the

invention as a whole, obviously.” In *re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in claim 9, obvious, and the present invention is patentable over such references.

Claims 10-23 and are allowable for the same reasons claim 9 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 9, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

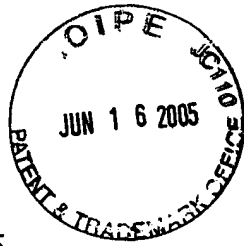
Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Ronit Gillon', is written over a horizontal line.

Ronit Gillon

Reg. No. 39,202



Dated: June 13, 2005
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313-1450 on June 13, 2005.

A handwritten signature in black ink, appearing to read "Benjamin J. Davis", written over a horizontal line.